

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 4092**
Kazunobu SAKAI : Attorney Docket No. 2005_2072A
Serial No. 10/563,369 : Group Art Unit 2841
Filed January 4, 2006 : Examiner Yuriy Semenenko
METHOD AND APPARATUS FOR : **Mail Stop: AF**
INSPECTING COMPONENT
MOUNTING ACCURACY

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of May 28, 2008, Applicant in the above-referenced U.S. patent application hereby requests consideration of the rejections that have been made by the Examiner.

The Examiner's Rejections

The Examiner rejects claims 1-6 as being indefinite, alleging that they failed to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More particularly, the Examiner considers claims 1 and 6 to be unclear as to why material of the inspection-use board has different properties on its surfaces. The Examiner states that if an inspection-use board is formed from a light transmitting material, then it should have both identical surfaces partially transmitting light and partially reflecting light equally on both surfaces, or if it has a reflecting surface disposed on a surface opposed to its component mounting slide, the surfaces should be different from each other by optical properties, some limitations point out such difference.

It is respectfully submitted that the Examiner is significantly misapprehending what is required under 35 U.S.C. §112, second paragraph, and confusing the requirements of the second paragraph of section 112 with the requirements for a specification under the first paragraph of 112.

Requirements for a Claim Under 35 U.S.C. §112, Second Paragraph

The statute itself states that the specification shall conclude with "one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention." This is distinct from the first paragraph of section 112, which requires that the specification contain a written description of the invention "and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make and use the same . . ."

Thus, the second paragraph of section 112 focuses on the definiteness of the language of the claim. The primary purpose of the requirement is to ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent. MPEP §2173. The Examiner's focus during examination of claims for compliance with the requirement for definiteness is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. MPEP §2173.02. Some latitude in the manner of expression and the aptness of the terms should be permitted even though the claim language is not as precise as the Examiner might desire. MPEP §2173.02. The essential inquiry is whether the claim set out and circumscribed a particular subject matter with a reasonable degree of clarity and particularity.

Simple breadth of a claim is not to be equated with indefiniteness. MPEP §2173.04, citing *In re Moore*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). (Emphasis added).

The Examiner's Rejection does not Address an Issue of Definiteness

Claims 1 and 6 are directed to methods for inspecting component mounting accuracy and a component mounting operation mounting a component held by component holding member on a board. One of these steps of the method mounts the inspection-use component with the component holding member in such a way that the reflecting surface of the inspection-use component is disposed in a component mounting position on a component mounting side-surface of an inspection-use board which is formed from a light transmitting material and which has a reflecting surface disposed on a surface opposed to the component mounting side-surface and facing the component mounting side-surface while correcting posture-displacement between the recognized holding posture and a reference holding posture. Thus, this particular method step informs one of ordinary skill in the art that part of the method for inspecting includes mounting the inspection-use component is mounted with an inspection-use board.

The method step further notes that the inspection-use board has a light transmitting material, and a reflecting surface on a surface that is opposed to the component mounting side-surface and facing the component mounting side-surface. The Examiner questions why the material of the inspection-use board has different properties on its surfaces. The answer is that, as described in the specification, this surface should be a reflecting surface. But the question of why a particular board has a particular property on one of its surfaces is not relevant to the issue of whether the claim is definite, i.e. whether the claim is sufficiently specific in identifying the scope of protection. The question of why relates to the particulars of how the invention operates, and is a matter for the specification, if necessary, to discuss. It is not an issue of definiteness. The Examiner's statement that it should have both identical surfaces partially transmitting light and partially reflecting light is not in fact the case, as is clear from the language of the claim.

The Examiner's further statement that there should be some limitation pointing out the difference in the surfaces is in fact present in the claim; the claim states that the light transmitting material has a surface that is opposed to the component mounting side-surface and facing the component mounting side-surface that is a reflecting surface. The particulars of the other surface are not addressed, as they do not need to be addressed. The Examiner's apparent requirement for

further specificity regarding the other surface is inappropriate, as such further specificity is a matter of breadth, and not definiteness. That is, one of ordinary skill in the art clearly understands the metes and bounds of the claim without such statement.

It is noted that Fig. 10, for example, readily illustrates the component mounting side-surface 7a and the reflecting surface 8a. As described in the specification, the diffuse reflection sheet 8 is provided in this embodiment. However, this is merely an example in the specification, and such specificity is not required in the claim.

The Examiner's Response to Applicant's Arguments

In section 5 on pages 4 and 5 of the Office Action, the Examiner provided a response to Applicant's arguments regarding the definiteness of the claim. After initially agreeing with Applicant's statement of the purpose of 35 U.S.C. §112, second paragraph, the Examiner goes on to note that "those of ordinary skill in the art will be unable to use this invention without information that one surface of the inspection-use board has special layer (diffusion layer) on it and opposite surface of the inspection-use board has not such layer." This statement by the Examiner makes clear that the Examiner is misapprehending what is required by 35 U.S.C. §112, second paragraph.

As discussed above, 35 U.S.C. §112, second paragraph requires that the claims be definite. It does not require the claims to be a guide to making and using the invention. This is not the purpose of the claims. As can be seen from the above quotation of the first paragraph of 35 U.S.C. §112, this is the purpose of the specification. The specification is required to provide sufficient information to use the invention. The claims have no such requirement.

The Examiner goes on to state that just giving the different names for different surfaces, such as a reflecting surface or irreflective surfaces, is insufficient "because if 'an inspection-use board is formed from a light transmitting material' as claimed in claim 1 and 6, then such board should have both identical surfaces partially transmitting light and partially reflecting light equally on both of the surfaces, another words such surfaces should be identical by the optical properties. However for the invention is important that these surfaces be different by optical properties."

The Examiner's statement is not completely understood. The Examiner appears to be stating that the claim should have further statements that there are different properties of the different surfaces. However, as discussed above, this is not required by 35 U.S.C. §112, second paragraph. What is required is that the claim be sufficiently definite so that one of ordinary skill in the art understand the scope of the claim.

In the claims, the inspection-use board is recited as being formed from a light transmitting material. It is recited as having a component mounting side-surface. It is further recited as having a reflecting surface that is disposed on a surface opposed to the component mounting side-surface. This is a complete recitation of the particular elements that are desired for the mounting step recited in claims 1 and 6. It is not necessary for definiteness to point out that the component mounting side-surface has different properties than the reflecting surface (if this is what the Examiner is in fact requiring).

The Examiner is Thanked for his Courtesy in Granting and Conducting the Telephone Interview to Discuss the Above Issues

In the telephone interview, the Examiner was kind enough to discuss the rejections on the record, and to indicate that the Examiner believed that the reflecting surface should be further specified as being a diffuse reflecting surface, for example. In other words, it was understood from the Examiner that the Examiner's position that merely referring to a reflecting surface of the inspection-use board was insufficient, and that whether it was a diffuse or specular reflecting surface should be specified.

However, as discussed above, regarding what is required under 35 U.S.C. §112, second paragraph, this is an issue of breadth, and not definiteness. It is noted for example that there are dependent claims that specify the reflecting surface as a diffuse surface, and dependent claims that specify the reflecting surface as a specular reflecting surface. Both are possible. Claim 1 is simply broader than either of these dependent claims, which is permissible.

Conclusion

It is accordingly submitted that the Examiner's rejection of the claims has no basis in the law. The claims are clearly definite. The Examiner's further requirement, to the extent that it is understood, is not based on 35 U.S.C. §112, second paragraph. To the extent that the Examiner is requiring further limitations in the claims, it appears that the Examiner is confusing breadth with definiteness. To the extent that the Examiner is questioning why a particular surface is the way it is, it appears that the Examiner is questioning the requirements of the specification with the requirements of the claim. The Examiner's rejection is respectfully submitted to be improper, and must be withdrawn. Such withdrawal is requested.

In view of the above remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact Applicant's undersigned representative.

Respectfully submitted,

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